

U.S.S.N. 09/975,786
Filed: October 11, 2001
AMENDMENT &
RESPONSE TO OFFICE ACTION

Remarks

Claims 1-34 are pending. Claim 16 has been canceled, and new claims 35-40 have been added. Support for new claims 35-37 can be found at least in original claims 1 and 16 and at page 6, lines 17-20. Support for new claims 38-40 can be found at least in original claims 26, 16, and 17 and at page 6, lines 17-20.

Rejections Under 35 U.S.C. § 102

Claims 1-6, 10-15, 18, 20, 24, 26-29, 33 and 34 have been rejected under 35 U.S.C. § 102(a) as anticipated by Santini, Jr. et al., *Angew. Chem. It. Ed.*, 2000, 39, 2396-2407 (“the Santini article”). Claims 17, 19, 21-23, and 25 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,787,898 to Santini Jr., et al. (“the Santini patent”). The rejections are respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). As evidenced in the attached Declaration under 37 CFR 1.131 by John T. Santini, Jr., Ph.D., neither the Santini article nor the Santini patent discloses or suggests applying a **time-varying** potential, through an electrochemical cell, to a primary electrode to corrode the primary electrode as required in claims 1-15. The Declaration furthermore shows that nothing in either the Santini article or the Santini patent expressly or inherently discloses, or remotely suggests, a microchip device that includes a **means for applying a time-varying potential** to the primary electrode in an amount effective to corrode the primary electrode when placed in contact with an electroconductive fluid, wherein the means comprises a counter electrode, as required by claims 17-34.

Accordingly, every element of the present claims clearly is not explicitly or inherently disclosed in either the Santini article or in the Santini patent. Therefore, the rejections under 35 U.S.C. § 102 are improper and should be withdrawn.

Rejection Under 35 U.S.C. § 103

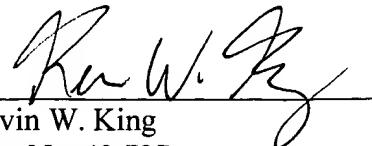
Claims 7, 8, 9, and 30-32 have been rejected under 35 U.S.C. § 103(a) as obvious over the Santini article in view of the Santini patent. The rejection is respectfully traversed.

No proper *prima facie* case of obviousness has been established, because the Office Action does not provide the required clear and particular showing that the prior art as a whole suggests the desirability, and thus the obviousness, of making the claimed combination of elements. As discussed above, the cited references each fail to disclose or suggest applying a **time-varying** potential, through an electrochemical cell, to a primary electrode to corrode the primary electrode, and neither reference alone discloses or suggests a microchip device that includes a **means for applying a time-varying potential** to a primary electrode in an amount effective to corrode the primary electrode when placed in contact with an electroconductive fluid, wherein the means comprises a counter electrode. This lack of disclosure or suggestion to include such features is not somehow provided by combining the Santini patent and the Santini article together. Accordingly, no *prima facie* case of obviousness has been established. The rejection is thus improper and should be withdrawn.

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Allowance of claims 1-15 and 17-40 is therefore earnestly solicited.

Respectfully submitted,



Kevin W. King
Reg. No. 42,737

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SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309-3996
(404) 853-8068
(404) 853-8806 (fax)